

REMARKS

Double Patenting Rejection

In the previous response to Office Action, the Applicants requested that the Examiner postpone his rejection under the judicially created doctrine of obviousness-type double patenting until the scope of the claims is finalized. The Examiner did not grant the postponement but did acknowledged that the Applicant's attempt was bona fide and gave the Applicants one month or thirty days to respond to the double patenting rejection.

In response, the Applicants are filing the following arguments against the double patenting rejection.

On page 6 of the previous Office Action dated September 9, 2003, Examiner rejected claims 1-14 and 16-29 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of US Patent No. 6,394,105.

The Examiner states "although the conflicting claims are not identical, they are not patentably distinct from each other because claims of the patent disclose means and step for controlling the laser in response to results obtained by analyzing the effect of cleaning. The scope of the term 'controlling' comprises continuing cleaning with or without changing the parameters of the cleaning. The continuing of the cleaning is directing the laser beam to remove the contaminants detected." The Applicants respectfully traverse.

In order to establish a *prima facie* rejection under the judicially created doctrine of obviousness-type double patenting the Examiner must use an analysis that parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). Therefore the factual inquiries set forth in

Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966) must be employed when making an obviousness double-type patenting rejection. The Graham factual inquiries are 1) determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue, 2) determine the difference between the scope and content of the patent claim and the prior art as determined in (1) and the claim in the application at issue, 3) determine the level of ordinary skill in the pertinent art, and 4) evaluate any objective indicia of non-obviousness.

Moreover, according to MPEP 804 any obviousness-type double patenting rejection should make clear A) the difference between the inventions defined by the conflicting claims -- a claim in the patent compared to a claim in the application; and B) the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in the claim in the patent. Independent claim 1 comprises subjecting the surface to a detector for sensing the surface for an irregularity in the smoothness of the surface; directing, on detecting an irregularity beyond a predetermined amount, a laser output to that irregularity; and energizing the laser to thereby impart an energy source to reduce the irregularity to a degree less than a predetermined amount. **Patent '105 does not teach or claim this invention.** It appears that the Examiner is attempting to equate "controlling" a laser output to directing, on detecting an irregularity beyond a predetermined amount, a laser output to that irregularity. However, the Examiner has not shown or given any reason why a person of ordinary skill in the art would conclude that controlling a laser output is an obvious variation of directing, on detecting an irregularity beyond a predetermined amount, a laser output to that irregularity. Therefore, the Applicants

respectfully submit that the Examiner has not met his burden for rejecting claim 1 under the judicially created doctrine of obviousness-type double patenting and request that the Examiner withdraw his rejection of independent claim 1.

Similarly independent claims 8, 13, 15, 16, 23 and 28 contain the same limitation of directing a laser beam to an irregularity. Therefore, the Applicants respectfully submit that the Examiner has not met his burden for establishing a prima facie case for rejecting these claims under the judicially created doctrine of obviousness-type double patenting and request that the Examiner withdraw his rejection of independent claims 8, 13, 15, 16, 23 and 28. Finally, since the dependent claims depend from their respective dependent claims and the Examiner has not established a prima facie for rejecting the independent claims the Applicants request that the Examiner withdraw his rejection of dependent claims 2-7, 9-12, 14, 17-22, 24-27 and 29.

Conclusion

In light of the above remarks and actions, this application should be considered in condition for allowance and the case passed to issue. If there are any questions regarding these remarks or the application in general, a telephone call to the undersigned would be appreciated to expedite prosecution of the application.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 19-1036**. Please credit any excess fees to such deposit account.

Respectfully submitted,
SEAGATE TECHNOLOGY LLC
(Assignee of Entire Interest)

Date

4/1/2004

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